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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/616,469	07/14/2000	Michael P. Lyle	RECOP004	6458
21912	7590	10/19/2004	EXAMINER	
VAN PELT & YI LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			HENEGHAN, MATTHEW E	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/616,469	Applicant(s) LYLE ET AL.	
	Examiner Matthew Heneghan	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 July 2004 has been entered.
2. Claim 4 has been amended in response to the first office action. Claims 1-7 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Details about what would specifically constitute a "packet that would be sent if the connectionless port were not in use," critical or

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essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicant discloses that an ICMP packet may be used, but does not specify which types of ICMP packets would be suitable.

The ICMP protocol comprises several dozen types of different messages, each having a different sub-code and a unique meaning. Some, but not all, of the known messages have meanings that might be appropriate in the context of the instant invention. Though it is clear that the invention could use a known sub-code when generating an ICMP message, the functionality described in the instant application does not clearly conform to any one of the well-known definitions for the ICMP functions; therefore, it is necessary for the specification to designate a particular sub-code within ICMP in order for the disclosure to be enabling. Undue experimentation would be required in order to implement a system having this functionality using Applicant's specification.

Given that the nature of the invention is that it is computer networking equipment in communication with external computers using industry standard protocols, the breadth of claim 1 is such that any message that would signify a port not being in use would satisfy the limitation; no message type was found in any protocol or in any prior art or working examples that would be compatible with Applicant's invention fits this definition; moreover, since this uses standardized implementations, one of ordinary skill in the art cannot be expected to use existing sub-codes for roles that do not necessarily apply to their standard definitions, or to create new sub-codes.

4. All previous rejections under 35 U.S.C. 112, second paragraph, have been withdrawn in view of Applicant's amendments.

Claim Rejections - 35 USC § 103

5. All previous rejections under 35 U.S.C. 103 have been withdrawn.

Response to Amendment

6. The declaration under 37 CFR 1.132 filed 6 July 2004 is insufficient to overcome the rejection of claims 1-7 based upon 35 U.S.C. 112, first paragraph as set forth in the last Office action because the it fails to show that a specific type of message that would signify a port not being in use was well-known in the art at the time the invention was made, as discussed above.

Response to Arguments

7. Applicant's arguments, see Remarks, p.5, filed 6 July 2004, with respect to the rejections under 35 U.S.C. 112, first paragraph have been fully considered but they are not persuasive, for the reasons discussed above.

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8. Applicant's arguments, see Remarks, p.5, filed 6 July 2004, with respect to the rejection of claim 4 under 35 U.S.C. 112, second paragraph, have been fully considered and are persuasive in view of Applicant's amendments. The rejection of claim 4 has been withdrawn.

9. Applicant's arguments, see Remarks, p. 6, filed 6 July 2004, with respect to the rejections of claims 1-7 under 35 U.S.C. 103 have been fully considered and are persuasive. The rejections under 35 U.S.C. 103 of claims 1-7 have been withdrawn.

Conclusion

10. In response to Applicant's request during the telephonic interview held on 18 May 2004 (see Remarks, filed 6 July 2004, p. 4) regarding the rejections under 35 U.S.C. 112, first paragraph, the Examiner has consulted with Andrew Caldwell, the Supervisory Primary Examiner of Art Unit 2137 (Cryptography and Computer Security). Mr. Caldwell has previously been a Primary Examiner in the Computer Networking area.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday from 8:30 AM - 4:30 PM Eastern Time. Beginning 21 October 2004, the telephone number is being changed to (571) 272-3834.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789 (beginning 21 October, (571) 272-3838).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900 (beginning in October, (571) 272-2100).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



October 15, 2004



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100